

## REMARKS

### **Change of Correspondence Address**

Applicant has included herewith a request for Change of Correspondence, so that all communications from the USPTO will be sent to the following contact and address:

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### **Rejection of Claims and Traversal Thereof**

In the February 5, 2008 Office Action:

claims 60-61 and 63-64 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP 06-070698; (hereinafter Sugimoto) and

claim 62 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sugimoto as applied above in view of Place et al. (US Patent No. 6,6261,590, hereinafter Place).

These rejections are hereby traversed and reconsideration of the patentability of the pending claims is therefore requested in light of the following remarks.

### **Rejections under 35 U.S.C. §103(a)**

Claims 60-61 and 63-64 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sugimoto. Applicants submit that Sugimoto does not in any way meet the necessary requirements to establish a *prima facie* case of obviousness.

The limitations of method claim 60 and claims depending therefrom include the following:

A method of preparing an animal feed composition, the method comprising (a) mixing a carotenoid and a phospholipid that is liquid at the body temperature of the animal to form a mixture; and (b) thereafter combining the mixture with at least one other animal feed component, **such that the carotenoid makes up at least 1%, by weight, of the composition and the phospholipid makes up at least 5%, by weight, of the composition.** (emphasis added)

Thus, the feed composition must include at least **1% by weight of the carotenoid** and at least **5% of the phospholipid**. The Sugimoto reference does not in any way describe, teach or suggest these levels of components.

The Office contends that one skilled in the art reading the Sugimoto reference would overlook the range set forth in the reference and modify same to go in the direction of applicants. Applicants vigorously disagree.

It should be noted that it is incumbent on the Office to view applicants' claimed invention as a whole. *In re Wesslau*, 174 U.S.P.Q. 393 (CCPA 1965). Concurrently, the Office **must** consider the invention of any cited reference in its entirety. Certain individual features from the references may not be arbitrarily chosen (while equally arbitrarily discarding other disclosed features) in an attempt to meet the features of the rejected claims. Thus, the Office is not allowed to pick and choose just certain parts of the reference but instead the entirety must be considered. Accordingly, the Office cannot depend on the statement by Sugimoto that the carotenoid is greater than 3mg, but instead must also recognize that Sugimoto clearly describes a range for the use of the carotenoid as recited on paragraph [012] it is stated the following;

“[0012]Although it is 0.1g/100g feed -10g/100g feed, quantity added in feed is added so that it may become the amounts 2g-10g of phospholipid/100g feed, and the amount of carotenoid of 3 mg - 100 mg/100g feed preferably.”

As such, the Sugimoto range for the **phospholipid in a feed composition is 0.1 % to 10% and preferably from 2% to 10%**. More important, it must be recognized by the Office that the range for the **carotenoid is from 0.003% to 0.1 % in the feed composition.** Clearly, because the carotenoid is added in milligrams then the range of inclusion in the feed composition results in a very low percentage in the feed compositions. Notably, the Sugimoto group found such low percentages of carotenoids in the feed composition to be very effective, and as such, why would

one skilled in the art be motivated to change the amount of carotenoids in the feed compositions. Notably the examples of Sugimoto showed that 10 mg of carotenoids in 100 g of feed (.001% by weight) was effective to reduce the level of formed peroxide (see Table 1, composition (3)). In example 3, Table 3, again the only amount of carotenoid used was 10 mg per 100 grams of feed (.01% of the feed composition). Clearly, sample 2 with .01% of carotenoid was effective. Thus, as stated above, this reference provides no indication or motivation to change the amount of carotenoids in a feed composition.

Further, there is no disclosure in the Sugimoto reference that teaches the amounts recited in the presently claimed invention and Office cannot conjure this up or speculate by relying on something that is not disclosed. The Court's decision in *In re Spormann*, 150 USPQ 449 (CCPA 1966), bears directly on point:

“Obviousness cannot be predicated on what is unknown”

Even in light of the *KSR* decision the Office is still required to present a *prima facie* case of obviousness, which clearly has not been established by the proposed modification of Sugimoto. Applicants respectfully submit that the Office has not provided any objective or specific teachings or suggestions in the cited prior art or knowledge known to the skilled artisan at the time of filing the present invention to motivate one skilled in the art to modify said reference. What is the asserted motivation put forth in Sugimoto to increase the amount of the carotenoid? The Courts have addressed this issue numerous times and have stated that “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

It appears that the Office has “simply retraced the path of the inventor with hindsight, discounted the number and complexity of the alternatives, and concluded that the invention... was obvious.” ( See *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories* (Fed. Circ. 2007-1223, decided March 31, 2008). Such an approach by the Office is clearly improper, as the language of U.S.C. Title 35 requires the Office to analyze “‘the subject matter as a whole’ to ascertain if it ‘would have been obvious at the time the invention was made.’ 35 U.S.C. § 103(a).” *Ortho-McNeil, supra*.

For these reasons, the Office has not met its burden of establishing a *prima facie* case of obviousness. The applicants therefore request that the rejection of claims 60-61 and 63-64 on the basis of obviousness be withdrawn.

2. Claim 62 rejected under 35 U.S.C. §103(a) as being unpatentable over Sugimoto in view of Place. Again applicants insist that neither reference alone or in combination defeats the patentability of the presently claimed invention. The shortcomings of Sugimoto, as discussed above, are not overcome by the introduction of Place. Applicants submit that the Office has not established a *prima facie* case of obviousness and requests that all rejections under section 103 be withdrawn.

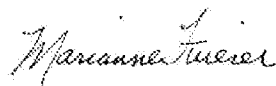
#### **Petition for Extension and Fees Payable**

Applicants petition for a one month extension to extend the response due date of May 5, 2008 to June 5, 2008 and the fee of \$60.00 is being paid herewith by electronic transfer. If any additional fee is found due for entry of this amendment, the Commissioner is authorized to charge such fee to Deposit Account No. 13-4365 of Moore & Van Allen.

#### **Conclusion**

Applicants have satisfied the requirements for patentability. All pending claims are free of the art and fully comply with the requirements of 35 U.S.C. §112. It therefore is requested that Examiner Huang reconsider the patentability of the pending claims in light of the distinguishing remarks herein, and withdraw all rejections, thereby placing the application in condition for allowance. If any issues remain outstanding incident to the allowance of the application, Examiner Huang is requested to contact the undersigned attorney at (919) 286-8089.

Respectfully submitted,



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